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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/822,686	03/30/2001	Thomas N. Turba	#RA 5362 (33012/309/101)	9229

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EXAMINER

NGUYEN, MERILYN P

ART UNIT

PAPER NUMBER

2171

DATE MAILED: 04/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/822,686

Applicant(s)

TURBA ET AL.

Examiner

Merilyn P Nguyen

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-20 are pending in this office action.

Specification

2. The disclosure is objected to because of the following informalities: status of copending application must be updated at pages 1-3 of the specification.

At page 4, line 10, there is unknown symbol after "MAPPER".

At page ~~13~~¹², line 15, there is missing word in "Data Wizard a web based interface".

Appropriate correction is required.

Claim Objections

3. Claims 1, 2, 6, 7, 11, 13, 16, and 18 are objected to because of the following informalities:

In claim 1, line 3; in claim 2, line 1; in claim 6, line 4; in claim 7, line 1; in claim 11, line 2; in claim 13, line 1; in claim 16, line 2; in claim 18, line 1: "publically" should be --publicly--.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 1-10, 15, and 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 and 6, the term “data wizard” expressed in a lowercase term, which renders the claim indefinite. The term “data wizard” is not defined by the claim, and the specification addresses data wizard as “Cool ICE Data Wizard” in capital, therefore the “data wizard” in the claim is indefinite and does not provide a standard for ascertaining the requisite degree.

Claims 5, 10, 15 and 19 contain the trademark/trade name MAPPER at line 2. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe database management system and, accordingly, the identification/description is indefinite.

Regarding claim 8, there is insufficient antecedent basis for “said data wizard one of said plurality of steps” in the claim.

Claims 9-10 depend from rejected claim 8 and include all the limitations, thereby inheriting its defects.

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Claims 2-5 and 7-10 depend from rejected claims 1 and 6, respectively, and include all the limitations, thereby inheriting its defects.

Claim 20 depends from rejected claim 19 and includes all the limitations, thereby inheriting its defects.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1, 6, 11, and 16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6, 11, and 16 of copending Application No. 09/821928. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are substantially similar in scope and they use the same limitations.

Regarding claims 1, 6, and 16 of the instant application, claims 1, 6, and 16 of the '928 application recite all the elements of claims 1, 6, and 16 of the instant application. Claims 1, 6,

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and 16 of the '928 application also includes additional elements that are not recited in the instant claims.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to omit the additional elements of claims 1, 6, and 16 of the '928 application to arrive at the claims 1, 6, and 16 of the instant application because the one would have realized that the remaining element would perform the same functions as before. "Omission of element and its function in combination is obvious expedient if the remaining elements perform same functions as before." See *In re Karlson* (CCPA) 136 USPQ 184, decide Jan 16, 1963, Appl. No. 6857, U.S. Court of Customs and Patent Appeals.

The subject matter of claims 2, 3, 5, 7-10, and 18-20 of the '928 application are same as claims 2, 3, 5, 7-10, and 18-20 of instant application.

Regarding claim 11 of the instant application, claim 11 of the '928 application recites all the elements of claims 11 of the instant application since claim 11 of the '928 recites and repeats the steps of claim 11 of instant application. The identifying steps of instant application are obviousness since the presenting steps of '928 application read on this limitation.

The subject matter of claims 13, 14, and 15 of the '928 application are same as claims 13, 14, and 15 of the instant application.

7. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

8. Claims 1-4, 6-9, 11-14, and 16-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Ensor (US 6,502,092).

Regarding claim 1, Ensor discloses in a data processing system (See Fig. 1) having a user terminal ("personal computer", 112a and 112b, Fig. 1) operated by a user which builds a service for accessing a data base management system (See Fig. 3, and col. 6, lines 31-50) responsively coupled to said user terminal via a publically accessible digital data communication network (See col. 6, lines 40-47), the improvement comprising:

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a data wizard (See Fig. 3, for example)¹ which permits said user to specify said service (See col. 6, lines 40-43) as a plurality of discreet and independent steps (See Fig. 3, and col. 6, lines 49-58)².

Regarding claim 2, Ensor discloses said publically accessible digital data communication network further comprises the Internet (102, Fig. 1, and col. 4, lines 60-61).

Regarding claim 3, Ensor discloses said user terminal further comprises an industry compatible personal computer (See 112a, 112b, Fig. 1) having a commercially available browser (See col. 6, lines 40-43).

Regarding claim 4, Ensor discloses said data wizard permits said user to define and edit each step in said plurality of steps independently of each of the other steps in said plurality of steps (See col. 7, lines 11-45, where “the selection of a particular table...of database” (lines 11-12) and “This entry box enables the user to change the number of rows to be retrieved” (lines 34-35) clearly read on the claimed of “data wizard permits said user to define and edit each step independently”).

Regarding claim 6, Ensor discloses apparatus (See Fig. 1) comprising:

- a. a user terminal (“personal computer” 112a, Figure 1);

¹ Please note that “data wizard” as defined in specification as a web based interface. Therefore, the user interface in the prior art reads on this limitation.

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- b. a data base management system responsively coupled to said user terminal via a publically accessible digital data communication network (See Fig. 3, and col. 6, lines 43-50); and
- c. a data wizard (See Fig. 3, for example)³ responsively coupled to said user terminal and said data base management system which permits a service to be defined from said user terminal (See col. 6, lines 40-43) in accordance with a plurality of discreet and independent steps (See Fig. 3, and col. 6, lines 49-58)⁴.

Regarding claim 7, Ensor discloses said publically accessible digital data communication network further comprises the Internet (102, Fig. 1, and col. 4, lines 60-61).

Regarding claim 8, Ensor discloses, as best as examiner ascertain, said data wizard one of said plurality of steps to be edited independently of each other of said plurality of steps (See col. 7, lines 11-45, where the changes of user's selection (lines 11-12 and 34-35) happened within the step of 'data edit').

² Please note that those options in Fig. 3, such as "Edit Data", "Copy Object/Data Wizard", "Configure Database Parameters", correspond to "a plurality of discreet and independent steps" since each of these steps are operable independence.

³ Please note that "data wizard" as defined in specification as a web based interface. Therefore, the user interface in the prior art reads on this limitation.

⁴ Please note that those options in Fig. 3, such as "Edit Data", "Copy Object/Data Wizard", "Configure Database Parameters", correspond to "a plurality of discreet and independent steps" since each of these steps are operable independence.

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Regarding claim 9, Ensor discloses said user terminal further comprises an industry compatible personal computer (See 112a, 112b, Fig. 1) containing a web browser (See col. 6, lines 40-43).

Regarding claim 11, Ensor discloses a method of dynamically building a service from a user terminal coupled via a publically accessible digital data network to a remote data base management system (See Fig. 3, and col. 6, lines 31-50) having a component building process comprising:

- a. identifying a first discreet and independent step (See col. 6, lines 50-52); and
- b. identifying a second discreet and independent step ordered subsequently to said first discreet and independent step (See col. 6, lines 54-58) ⁵.

Regarding claim 12, Ensor further discloses editing said first discreet and independent step without modification to said second discreet and independent step (See col. 7, lines 11-45).

Regarding claim 13, Ensor discloses publically accessible digital data communication network further comprises the world wide web (See col. 11, lines 21-23).

Regarding claim 14, Ensor discloses said user terminal further comprises an industry compatible personal computer (See 112a, 112b, Fig. 1).

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Regarding claim 16, Ensor discloses an apparatus comprising:

a. means for permitting a user to access a publically accessible digital data communication network (See col. 6, lines 43-46);

b. means responsively coupled to said permitting means via said publically accessible digital data communication network for providing data base management services (See col. 6, lines 40-43); and

c. means responsively coupled to said permitting means and said responding means for designing a service through specification of an ordered plurality of discreet and independent steps (See Fig. 3, and col. 6, lines 49-58)⁶.

Regarding claim 17, Ensor discloses said designing means further comprises a means for editing at least one of said plurality of discreet and independent steps (See col. 7, lines 11-45).

Regarding claim 18, Ensor discloses said publically accessible digital data communication network further comprises the Internet (102, Fig. 1, and col. 4, lines 60-61).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

⁵ Please note that those options in Fig. 3, such as "Edit Data", "Copy Object/Data Wizard", "Configure Database Parameters", correspond to "a plurality of discreet and independent steps" since each of these steps are operable independence.

⁶ Please note that those options in Fig. 3, such as "Edit Data", "Copy Object/Data Wizard", "Configure Database Parameters", correspond to "a plurality of discreet and independent steps" since each of these steps are operable independence.

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 5, 10, 15, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ensor (US 6,502,092), in view of Applicant's Admitted Prior Art.

Regarding claims 5, 10, 15, and 19, Ensor discloses a database management system (See Fig. 3) having all of the claimed subject matter except Ensor is silent as to the database management system being a MAPPER data base management system. Applicant admits that the MAPPER database management system was known at the time the invention was made. Since MAPPER DBMS was readily available, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to use the well known MAPPER data base management as disclosed by Applicant's Admitted Prior Art as the database management system of Ensor. The resultant use of the MAPPER data base management system would have performed the intended (by Ensor) function, without undue experimentation and with expected and obvious result (See applicant's specification, page 4, lines 7-12).

Regarding claim 20, Ensor discloses said permitting means further comprises an industry standard personal computer (See 112a, 112b, Fig. 1).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Bac U.S Patent No. 6,295,531 discloses cool ice data wizard.

Regnier U.S Patent No. 6,134,549 discloses client/server computer system having personalizable and securable views of database data.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marilyn P Nguyen whose telephone number is 703-305-5177. The examiner can normally be reached on M-F: 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

MN

MN

April 23, 2003



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